REMARKS

Claims 1-24 are currently pending in the subject application and are presently under consideration. A version of all pending claims is found at pages 2-6. Claims 1, 9, 13, 17, 22-24 have been amended herein to cure minor typographical errors as well as to further emphasize novel aspects of applicants claimed invention. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I.   Rejection of Claims 1-24 Under 35 U.S.C. §101

Claims 1-24 stand rejected under 35 U.S.C. §101 because the claimed invention lacks patentable utility. Withdrawal of this rejection is respectfully requested for at least the following reasons. Independent claims 1, 9, 13, 17 and 22 have been amended to comport with the Examiner's suggestion in order to overcome this rejection. In addition, independent claim 23 has been amended to further emphasize novel aspects of the claimed invention and it is now believed that the subject claim is directed towards statutory subject matter. Further, applicants' representative disagrees with the Examiner's characterization with respect to independent claim 24.

> Because the claimed process applies the Boolean principle [abstract idea] *to produce a useful, concrete, tangible result* ... on its face the claimed process comfortably falls within the scope of §101. *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358. (Fed.Cir. 1999) (Emphasis added); *See State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed.Cir.1998). The inquiry into patentability requires an examination of the contested claims to see if the claimed subject matter, as a whole, is a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea," or if the mathematical concept has been *reduced to some practical application rendering it "useful."* *AT&T* at 1357 *citing In re Alappat*, 33 F.3d 1526, 31 1544, 31 U.S.P.Q.2D (BNA) 1545, 1557 (Fed. Cir. 1994) (emphasis added).

With respect to independent claim 23, the Examiner merely asserts, without providing a rationale for rejecting the subject claim, that "a data packet is a data structure". *See* Office Action (dated January 10, 2005), page 3. Applicants'

- 7 -

representative contends that a conclusory assertion without more does not meet the sufficiency of the Examiner's burden with respect to this rejection, and thus it is submitted, the Examiner has failed to set forth *prima facie* grounds to substantiate the rejection under 35 U.S.C. §101 with respect to this claim.

Further, according to *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), the legal standard set forth by the Federal circuit for determining whether claims are directed towards statutory subject matter is whether the claims can be applied in a practical application to produce a useful, concrete and tangible result. The subject claim clearly meets the aforementioned legal standard. Independent claim 23 as amended recites: *a data packet transmitted as a communication signal* between at least two computer processes comprising a configurable module having: one or more configurable data elements, wherein one or more default values for the one or more configurable data elements are available; one or more non-configurable data elements describing the one or more configurable data elements; and one or more transformation instructions that facilitate configuring the one or more configurable data elements, wherein *the instructions are employed to facilitate installation of the one or more configurable data elements into a target data set residing in at least one of the at least two computer processes*. Thus, claim 23 recites independent acts (transmitting a data packet comprising a configurable module as a communication signal between at least two computer processes) that facilitates the installation of configurable data elements into a target data set that resides in at least one of the at least two computer processes. Such independent acts produce a concrete, tangible and useful result – namely, the transmission of a configurable module to one or more computer processes to aid in the installation of configurable data elements into a target data set resident on at least one of the at least two computer processes.

With respect to independent claim 24, the Examiner once again merely provides a conclusory statement – "Claim 24 is drawn to a data structure" – without providing a rationale for the rejection under 35 U.S.C. §101. As was stated above in connection with the rejection of independent claim 23, the Examiner has clearly failed to set forth a *prima facie* case to substantiate the rejection of independent claim 24, and as a consequence has failed to satisfy the sufficiency of his burden in this regard. Further, independent claim

- 8 -

24 recites *a computer readable medium having stored thereon a data structure*, this alone provides ample substantiation to characterize the data structure as being "functional descriptive material" recorded on computer readable media such that the data structure becomes structurally and functionally interrelated with the media and thus statutory for the purposes of 35 U.S.C. §101. *See* MPEP §2106(IV)(B)(1). Moreover, the subject claim provides that the data structure is not only stored on the computer readable media but is also utilized to load configurable data elements into a software program – a useful, concrete and tangible result – therefore satisfying the legal requirement set forth by the Federal Circuit in *AT&T Corp. v. Excel Communications, Inc.*

In view of at least the foregoing, it is apparent that applicants' claimed invention produces a useful, concrete and tangible result pursuant to *AT&T Corp. v. Excel Communications, Inc.* Accordingly, this rejection should be withdrawn with respect to independent claims 1, 9, 13, 17, 22, 23 and 24, and claims that depend there from.

II.   Rejection of Claims 1-24 Under 35 U.S.C. §102(b)

Claims 1-24 stand rejected under 35 U.S.C. §102(b) as being anticipated by Microsoft's Visual C++ version 5.0 as documented in the text book, "Beginning Visual C++ 5", by Ivor Horton, published March 19, 1997 (hereinafter "Horton"). Reversal of this rejection is respectfully requested for at least the following reasons. The cited document fails to disclose each and every limitation set forth in the subject claims.

> A single prior art reference anticipates a patent claim only if it *expressly or inherently describes each and every limitation set forth in the patent claim.* Trintec Industries, Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The *identical invention must be shown in as complete detail as is contained in the ... claim. Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Applicants' claimed invention relates to a system and method for creating and describing a configurable merge module wherein a data set in the configurable merge module is configured, and the resultant configured data set is merged into a target data

09/770,705   MS155721.02/MSFTP139USA

set. In particular, the invention as claimed relates to creating, describing and configuring software components (that are data sets) to be incorporated into software programs (target data sets) such that the software components are self-describing in relation to configuration possibilities for the particular software program. More particularly, independent claims 1, 9, 13, 17, 22, 23 and 24 recite similar claim limitations, namely: ... *installation of the one or more configurable data elements into at least one target data set.* Horton does not disclose this novel aspect of applicants' claimed invention.

The Office Action asserts that Horton provides substantiation for the rejection of the subject claims under 35 U.S.C. §102. Applicants' representative respectfully disagrees. Horton discloses the creation and utilization of dynamic link libraries, and in particular that a dynamic link library is a file containing a collection of modules that can be used by any number of different programs. However, Horton does not teach or suggest the installation of one or more configurable data elements into at least one target data set, thereby transforming the at least one target data set with configurable data elements. Moreover, Horton reiterates this point by stating at page 718 that: "[no] code from a DLL is included [installed] in the executable module of any of the programs." In contrast, the invention as claimed installs and/or loads configurable data elements into target data sets through the use of transformation instructions applied to configurable data elements to effectively modify/transform the target data set with the configurable elements obtained from a transformation component.

In addition, applicants' representative contends that the Office Action misconstrues and mischaracterizes the target data set as claimed as being equivalent to a runtime environment. Target data sets as provided in the subject application are software programs. (*See* page 2, lines 22-23). A runtime environment in contrast is a transient state wherein the utilization of a DLL has no transformative effect on the underlying invoking software program, i.e. when the runtime environment has terminated, the program(s) invoking the DLL as well as the DLL itself, are left in exactly the same condition that they were in prior to the execution and invocation of the DLL – unchanged/untransformed. The invention as claimed on the other hand forces a transformation such that after utilization of the claimed invention the resultant modified target data set is no longer the entity that it was prior to the utilization of the claimed

- 10 -

invention.

The Office Action further appears to mischaracterize applicants' claimed invention as merely manipulating and updating linkages between a DLL and a program that invokes the DLL. As has been stated *supra*, the invention as claimed incorporates/installs software components (that are configurable data elements) into software programs (that are target data sets), such that by the act of incorporating/installing software components into software programs, a software program is transformed from being a software program without a particular software component to being a software program with a particular software component incorporated/installed therein. Thus, the invention as claimed rather than merely manipulating and updating linkages between an external DLL and an invoking program such that the external DLL and invoking program remain separate and distinct, incorporates/installs software components into the body of the software program thereby rendering a unitary entity.

Further, the examiner is reminded that the standard by which anticipation is to be adjudged is *strict identity* between the cited document and the invention as claimed, not mere equivalence or similarity. *See, Richardson* at 9 USPQ2d 1913, 1920. This means that in order to establish anticipation under 35 U.S.C. §102, a single document must not only expressly or inherently describe each and every limitation set forth in the patent claim, but also the identical invention must be shown in as complete detail as is contained in the claim. It is submitted that Horton does not provide the necessary identity to substantiate the rejection under 35 U.S.C. §102, and in particular the cited document does not provide for the installation of configurable data elements into a target data set thereby rendering a single indivisible entity - a software program.

In view of at least the foregoing, it is respectfully submitted that the rejection of independent claims 1, 9, 13, 17, 22, 23 and 24, and associated dependent claims, should be withdrawn.

- 11 -

09/770,705   MS155721.02/MSFTP139USA

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP

Himanshu S. Amin
Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731

- 12 -